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In re Application of :  
Noel Lee :  
Application No. 10/753,066 : ON PETITION  
Filed: January 6, 2004 :  
Attorney Docket No.: P1560 :

This is a decision on the "Petition to Withdraw Terminal Disclaimer Before Patent Issuance" filed July 8, 2008.

The petition is **dismissed**.

A review of the application file history reveals that on June 29, 2006, a terminal disclaimer was filed to obviate a double patenting rejection over a pending reference application, non-provisional application 10/655,494. The terminal disclaimer was deemed necessary to overcome a double patenting rejection of Claims 1-19 of application 10/753,066 as being unpatentable over Claims 1-22 of application 10/655,494. The instant petition now requests that the terminal disclaimer be withdrawn because application 10/655,494 is in an abandoned status and will not issue into a patent.

Section 1490 of the Manual of Patent Examination Procedure, provides, in pertinent part, that, "[p]etitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered." Such is the case with instant petition, as the reason given for withdrawing the terminal disclaimer is based on circumstances that are fluid and, arguably, likely to change in the future. A review of the application file history of application 10/655,494 reveals that the application became abandoned on February 28, 2007, for failure to respond to a non-final Office action mailed November 28, 2007. Although the application is in an abandoned status, the application has not been expressly abandoned pursuant to 37 CFR 1.138 and can be revived at any point. The future status of application 10/655,494 is unknown. As the reference application may be returned to pending status, withdrawal of the terminal disclaimer based on the present abandonment of application 10/655,494 would not be proper. The petition is dismissed accordingly.

It is noted that petitioner filed the instant petition as a petition under 37 CFR 1.59 to expunge the terminal disclaimer. The petition is appropriately considered under 37 CFR 1.182. See MPEP 1490. The petition fee is \$400.00. Any renewed petition must be accompanied by an additional \$200.00 in satisfaction of the petition or the renewed petition will be summarily dismissed.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin  
Petitions Attorney  
Office of Petitions